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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,336	10/30/2001	Bernhard Lettmann	IN-5530	2515
77224	7590	06/04/2009	EXAMINER	
Mary E. Golota Cantor Colburn LLP 201 W. Big Beaver Road Suite 1101 Troy, MI 48084			NUTTER, NATHAN M	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			06/04/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/018,336	<b>Applicant(s)</b> LETTMANN, BERNHARD	
	<b>Examiner</b> Nathan M. Nutter	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,18,19,21,22,25,26,28 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,18,19,21,22,25,26,28 and 42-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Application Re-Assignment***

This application has been re-assigned to Primary Examiner Nathan M. Nutter of Art Unit 1796. Contact information for Mr. Nutter will appear at the end of this Office Action.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 February 2009 has been entered.

Claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-53 are now pending.

### ***Response to Amendment***

In response to the amendment filed 17 February 2009, the following is placed in effect.

The rejection of claims 3, 18-19, 21-22, 25-26 and 28 under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al (US 6,403,701), is hereby expressly withdrawn.

The rejection of claims 3, 18-19, 21-22, 25-26 and 28 under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al (US 6,403,701) in view of Schwarte et al (US 6,001,915), is hereby expressly withdrawn.

The rejection of claims 3, 18-19, 21-22, 25-26 and 28 under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al (US 6,403,701) in view of Kawakami et al (EP 0 081 994), is hereby expressly withdrawn.

The following new grounds of rejection are being presented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

MPEP §§ 2163.06 and 714.02 state that, when Applicant presents an amendment to the claims, "Applicant should specifically point out the support for any amendments made to the disclosure." Examiner has re-read the Specification, and it is unclear what elements therein correspond to the claimed percents by weight of the constituents (a21), (a22) and (a23) since the Specification does not utilize these

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parameters for polymer (A1) which differs in scope with polymer (AII) to which reference is made at page 71 (line 5) to page 72 (line 18). It is clear, and applicant has argued, the two components are different. As such, the amendment is improper.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al (US 6,403,701) taken in combination with Brock et al (US 5,672,649)

The instant invention is drawn to a process for preparing an aqueous coating material having desirable shade and optical effects, wherein said process comprises mixing of at least three components termed modules comprising: module (I) containing less than 5% by weight water, at least one binder, at least one pigment, and at least one organic solvent to form a base color (A1); module (II) comprising at least one aqueous color module comprising at least one water-soluble or -dispersible binder, at least one color pigment and water to form at least one aqueous color-imparting base color (A2); and module (III) comprising at least one pigment-free mixing varnish module (B) comprising at least one aqueous, pigment-free varnish comprising water-soluble or-

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dispersible binder and water; and optionally at least one rheology control additive (C).

Modules (I), (II) and (III) are stored separately and may be mixed before using. The nature of the binder(s) is not critical.

The reference to Reusmann et al teaches the a mixing system for producing water-dilutable coatings which may have “precisely defined tinting from various base colors” and “with effect finishes” and “special-effect pigments.” Note column 1 (lines 5-30). Reusmann et al teach the steps of: preparing a plurality of base colors; separately storing each of said base colors, and mixing, shortly before application of the coating composition. Note the Abstract, column 2 (line 61) to column 3 (lines 1 et seq.). The water-dilutable coating compositions may comprise a plurality of base colors (A) and at least one pigment-free component (B). The reference teaches the employment of at least one rheology-controlling additive. Note column 1 (lines 63-67). The base colors (A) comprise less than 5% by weight of water, at least one pigment, an organic solvent, and at least one water-dilutable first binder. The component (B) comprises a pigment-free an aqueous dispersion of polyurethane resin (second binder). Note claim 1. The component (A) is readable on the claimed (A-1) base color in the claimed module (I). The component (B) is readable on the claimed aqueous, pigment-free varnish module (III). The first binder (A) and the second binder in the component (B) can be the same binder. Note column 13 (23-29) column 4 (lines 49-59) and column 9 (lines 7-16). The polyurethane resins can be prepared from an isocyanate-functional prepolymer at the paragraph bridging column 5 to column 6, and “the groups of component (c) which are capable of forming anions are neutralized.” Note column 7 (lines 14 et seq.). The water-

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dispersible polyurethane binder composition may contain polyacrylate, polyester and amino resins. Note column 11 (lines 18-26). The reference teaches the addition of a rheology-controlling agent, which embraces the optionally claimed component (C) at column 11 (lines 1-17). Suitable groups capable of forming anions include carboxyl groups. Note column 7 (lines 55-60). The coating composition is taught to comprise a plurality of base colors (A). The base colors (A) comprise a combination of at least one organic coloring pigment and at least one inorganic coloring pigment. Note column 12 (lines 56-59) and column 3 (lines 7-35). Suitable special-effect pigments can also be present at column 3 (lines 18-28). The solvents are water-soluble or water-thinnable solvents including alcohols. Note column 4 (lines 60-65). The reference discloses a process for preparing components (A) and (B), and directly after their preparation by mixing the component (A) and (B), the coating compositions may be applied to the substrate by spraying. Note column 13 (lines 43-56). The base colors compositions (A) can be mixed with a suitable amount of the aqueous component (B). Reusmann et al discloses a formulation of a water-dilutable coating composition, which can be diluted with water, with or without prior partial removal of the organic solvent employed in the preparing resin. Note column 11 (line 18) to column 12 (line 7) and column 13 (lines 7-17). The coating composition of Reusmann et al can include a plurality various of base colors (A), wherein "coloring pigments usually takes place by dispersing the respective pigments with one or more of the above-described binders." Note column 5 (lines 28-32).

The reference to Reusmann et al does not show the component (A2) as a separate module of an aqueous color module comprising pigment, binder and water. The reference does not show three modules as the mixing system. The reference does disclose a mixing system that may comprise many modules as used for coating compositions using a plurality of base colors (A) separately storing each of said base colors. Note column 15 (lines 48-67), column 16 (lines 1-10 and 65-67) and claim 1. Also, the reference shows the use of a component (A) that may contain from 20 to 80% by weight of at least one water-thinnable or water-dispersible binder. Note the paragraph column 12 (lines 22 et seq.).

The reference to Brock et al teaches the production and use of an aqueous coating system using modules. The Abstract teaches the employment of an aqueous module that comprises the system noted in the instant claims as (A2). Further, note column 2 (lines 49 et seq.) and column 3 (lines 5-19 and 24-64). The use of anionic binders are taught at column 4 (lines 29-32). At the paragraph bridging column 6 to column 7, the reference teaches the employment of a lacquer system (herein, III). Further, note column 7 (lines 34-67). The reference clearly shows the modules designated as (A2) and (IV), since at column 3 (lines 56-61) the reference teaches the use of "a rheology module."

Both references are drawn to aqueous coating mixer systems comprising modules. Since both are aqueous systems, the modules may be used from one in the other with a great expectation of success by the artisan having an ordinary skill in the art. Since the reference to Reusmann et al shows the modules for use, although the



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rheology module is not separate, but as an additive in other modules, as herein claimed, the use of a rheology module, as taught by Brock et al would have been a prima facie obvious step. Likewise, the use of the modular system (A2) as taught by Brock et al, in the mixer system of Reusmann et al would have been an obvious step. The references are drawn to identical systems that employ some differing modules. Both systems are aqueous-based systems. As such, inclusion of the modules taught by Brock et al for the many modules disclosed by Reusmann et al would have been a prima facie obvious modification. Nothing unexpected has been shown on the record.

### ***Response to Arguments***

Applicant's arguments with respect to claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-53 have been considered but are moot in view of the new ground of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/  
Primary Examiner, Art Unit 1796

nmn

29 May 2009